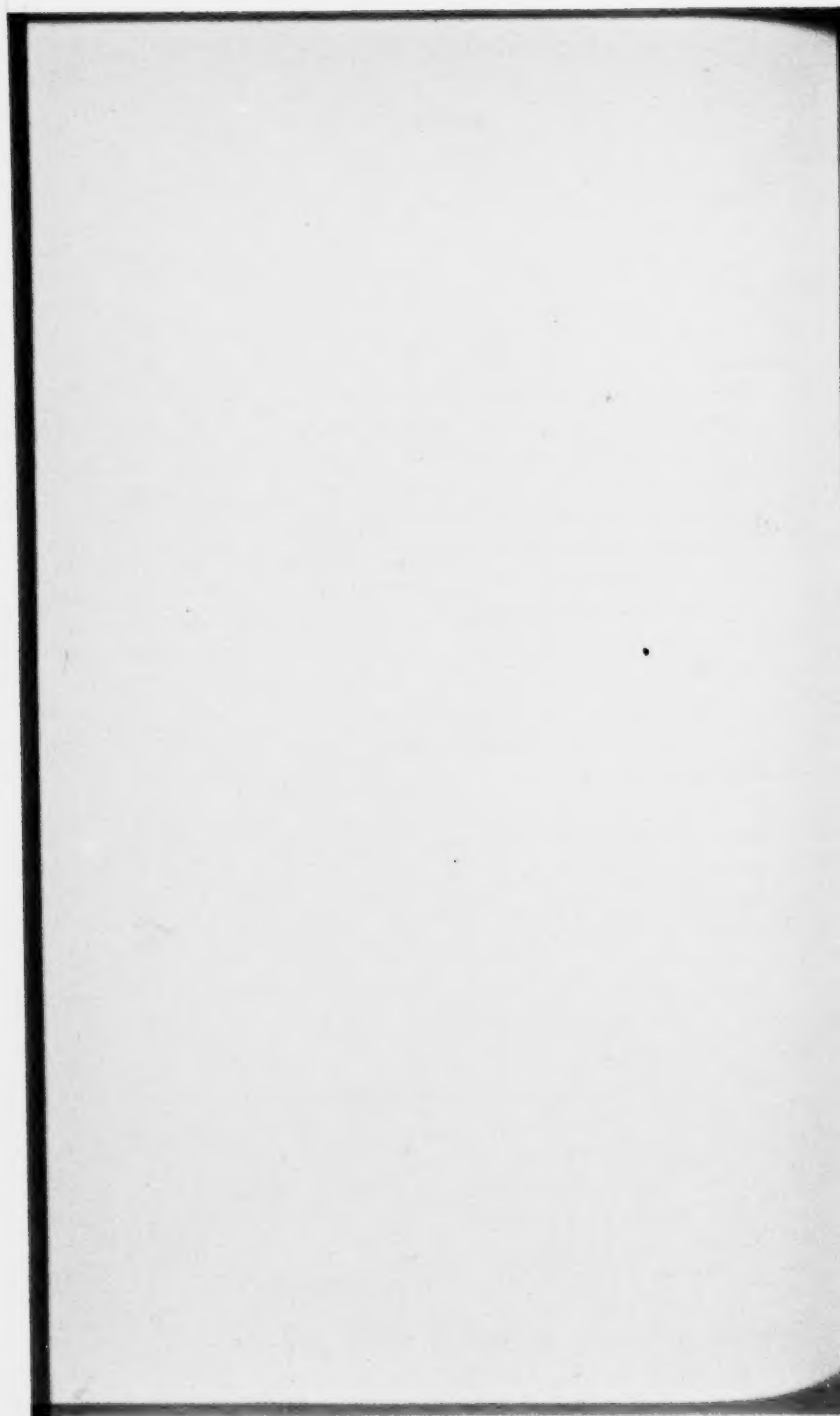


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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1921.

No. 791.

AMERICAN STEEL FOUNDRIES,
Appellant,

vs.

THOMAS E. ROBERTSON, Commissioner of Patents, and SIMPLEX
ELECTRIC HEATING COMPANY,
Appellees.

BRIEF FOR APPELLANT.

STATEMENT OF THE CASE.

Question Presented.

The sole question presented is whether the proprietor of a trade-mark whose application for registration thereof has been refused by the Commissioner of Patents and the Court of Appeals of the District of Columbia, may file a bill in equity under U. S. Rev. Stat., Section 4915. The United States District Court for the Northern District of Illinois, Eastern Division, answered this question in the negative and dismissed appellant's bill of complaint for want of jurisdiction.

The Facts.

(1) On May 19, 1917, the appellant, American Steel Foundries, filed an application in the United States Patent Office for registration of the trade-mark "SIMPLEX" as applied to brake rigging, brake heads, brake beams, brake shoes, brake hangers, and clasp brakes.

(2) On February 23, 1918, the Commissioner of Patents affirmed the refusal of the Examiner of Trade-Marks to register appellant's said trade-mark "SIMPLEX" on the ground that it consisted merely in the name of a corporation, the Simplex Electric Heating Company, and was therefore not registrable under Section 5 of the Trade-Mark Act of February 20, 1905.

(3) On May 5, 1919, the Court of Appeals of the District of Columbia rendered a decision affirming that of the Commissioner of Patents refusing to register appellant's trade-mark.

(4) On June 23, 1919, a petition for a writ of certiorari was filed, which was granted by this court and the writ issued on October 16, 1919.

(5) On January 12 and 13, 1921, the case was orally argued before this court without any question being raised either by the court or by counsel as to the jurisdiction of this court.

(6) On April 11, 1921, the cause was dismissed by this court for want of jurisdiction (256 U. S., 40) upon the ground that the decree of the Court of Appeals of the District of Columbia was not a final one, and that hence the writ of certiorari had been improvidently granted, reference being made to the decision of the same date in *Baldwin v. Howard* (256 U. S., 35).

(7) On June 24, 1921, appellant filed its bill of complaint, under Section 9 of the Trade-Mark Act and U. S.

Rev. Stat., Section 4915, in the United States District Court for the Northern District of Illinois, Eastern Division, the Commissioner of Patents consenting to the jurisdiction of the court.

(8) On August 31, 1921, an answer was filed by Commissioner of Patents, and on September 8, 1921, the Simplex Electric Heating Company filed a petition to intervene and defend, which petition was, upon stipulation, granted.

(9) On September 9, 1921, the Simplex Electric Heating Company filed a motion to dismiss the bill of complaint for lack of jurisdiction of the court "over the subject-matter or alleged cause of action."

(10) On January 6, 1922, the District Court granted the motion to dismiss the bill of complaint for want of jurisdiction, without rendering an opinion.

(11) On February 4, 1922, an appeal to this court was allowed and a certificate of the District Court filed to the effect that the dismissal of the bill of complaint "was a decree on the sole question of jurisdiction of the court."

Specification of Errors.

The decree of the District Court is alleged to be erroneous in that it holds that Section 9 of the Trade-Mark Act of February 20, 1905, does not give an applicant for the registration of a trade-mark the right to proceed by bill in equity under Section 4915 R. S.

Statutes Involved.

Section 9 of the Trade-Mark Act of February 20, 1905, which reads as follows:

"Sec. 9. That if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the court of appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable."

Section 4915 of the United States Revised Statutes, which reads as follows:

"Sec. 4915. *Patents obtainable by bill in equity.* Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

Point of Law Relied Upon.

Section 9 of the Trade-Mark Act of February 20, 1905, confers upon an applicant for the registration of a trade-mark the right to file a bill in equity under Section 4915 R. S.:

Gaines v. Knecht, 212 U. S., 561.

Atkins v. Moore, 212 U. S., 285.

Baldwin v. Howard, 256 U. S., 35.

American Steel Foundries v. Whitehead, 256 U. S., 40.

BRIEF.

The District Court dismissed appellant's bill of complaint solely on the ground that Section 9 of the Trade-Mark Act of February 20, 1908, does not give the proprietor of a trade-mark the right to file a bill in equity under Sec. 4915 R. S., notwithstanding four decisions of this court, in each of which it was held that Section 9 of the Trade-Mark Act did confer upon applicants for the registration of trade-marks the right to proceed as applicant did, namely, by filing a bill in equity under Sec. 4915 R. S. after registration had been refused by the Commissioner of Patents and the Court of Appeals of the District of Columbia.

The decisions in the four cases alluded to were based upon the holding that the decision of the Court of Appeals of the District of Columbia in cases appealed from decisions of the Patent Office are not final, and hence not reviewable by this court either by way of appeal or by the issuance of a writ on certiorari, inasmuch as such decisions of the District of Columbia Court of Appeals do not conclude the controversies between the parties, as such controversies can be continued through the filing of a bill in equity under Sec. 4915 R. S.

As Section 4915 specifically relates to applications for patents, in holding that the procedure permitted by said section prevented a decision of the Court of Appeals of the District of Columbia from being final in appeals from the Commissioner of Patents in trade-mark cases, this court necessarily held that procedure under Sec. 4915 was rendered available to applicants for the registration of trade-marks through the provision of Section 9 of the Trade-Mark Act, that an applicant for registration of a trade-mark may appeal to the Court of Appeals of the District of Columbia on complying with the conditions required in case of an appeal by an applicant for a patent, and that "the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable."

In *Frasch v. Moore*, 211 U. S., 1, this court held that no appeal lies from the decision of the Court of Appeals of the District of Columbia in an appeal from the decision of the Commissioner of Patents in a patent application, for the reason that such a decision of the Court of Appeals is not final, whether favorable or unfavorable to the applicant. This court stated that if such a decision of the Court of Appeals of the District of Columbia affirms the decision of the Commissioner of Patents refusing a patent to applicant, such decision is not final, because the applicant may further prosecute his application by bill in equity under Sec. 4915 R. S., and that if such decision reverses the decision of the Commissioner of Patents, it is not final because it does not preclude any person from contesting the validity of the patent granted pursuant to such decision of the Court of Appeals of the District of Columbia.

In *Frasch v. Moore*, this court, after quoting Section 4915 R. S., and in reference to the last clause thereof, "all the expenses of the proceeding shall be paid by the

applicant, whether the final decision is in his favor or not," said (p. 9):

"The final decision referred to is obviously the judicial decision on the bill in equity, while in interference cases and in all others going up from the Commissioner to the Court of Appeals there is no final judgment in the cause, but one interlocutory in its nature and binding only upon the Commissioner 'to govern the further proceedings in the case.' The opinion or decision of the court reviewing the Commissioner's decision is not final, because it does not preclude any person interested from contesting the validity of the patent in court, and if the decision of the Commissioner grants the patent that is the end of the matter as between the Government and the applicant; and if he refuses it and the Court of Appeals sustains him, that is merely a qualified finality, for, as we have seen, the decision of that court may be challenged generally and a refusal of patent may be reviewed and contested by bill as provided."

In *Gaines v. Knecht*, 212 U. S., 561, this court applied the rule in the *Frasch* case in dismissing a writ or error from the decision of the Court of Appeals of the District of Columbia in an appeal from the Commissioner of Patents in a trade-mark opposition proceeding, the *per curiam* decision reading as follows (p. 562):

"*Per Curiam*: Writ of error dismissed for want of jurisdiction. *Frasch v. Moore*, 211 U. S. 1. See act of February 20, 1905, for the registration of trade-marks, c. 592, 33 Stat. 724, §§ 9, 16, 17, 18, *et passim*."

Two months subsequent to the decision in *Gaines v. Knecht*, this court rendered a decision in *E. C. Atkins & Co. v. Moore*, 212 U. S., 285, which was an appeal from a decision of the Court of Appeals of the District of Columbia in an appeal from the Commissioner of Patents by an applicant for the registration of a trade-mark, and in which the facts before the court in *Gaines v. Knecht*

were reviewed and the following statement made with respect thereto (p. 291):

“In the light of the various details of the act of February 20, 1905, and of the specific provisions of § 9, we were of opinion that proceedings under the act were governed by the same rules of practice and procedure as in the instance of patents, and the writ of error was accordingly dismissed. The same result must follow in the present case.”

This court concluded its opinion in *Atkins v. Moore* with the statement (p. 291):

“Under § 4914 of the Revised Statutes no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes ‘any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question,’ and by § 4915 a remedy by bill in equity is given where a patent is refused, and we regard these provisions as applicable in trade-mark cases under § 9 of the act of February 20, 1905.”

This court therefore in *Gaines v. Knecht*, and *Atkins v. Moore* expressly held that Section 9 of the Trade-Mark Act conferred upon the applicant for registration of a trade-mark the right to file a bill in equity under Section 4915 R. S., and hence the decision of the District of Columbia Court of Appeals affirming the decision of the Commissioner of Patents denying registration was not final, and consequently not reviewable by this court.

In *Baldwin v. Howard*, 256 U. S., 35, decided April 11, 1921, this court had before it both an appeal and a petition for writ of certiorari in a decision of the Court of Appeals of the District of Columbia rendered in an appeal from a decision of the Commissioner of Patents in a trade-mark cancellation proceeding, and reviewed the decisions in *Frasch v. Moore*, *Gaines v. Knecht*, and *Atkins v. Moore*, and quoted as follows from the last decision (p. 39):

“ . . . by § 4915 a remedy by bill in equity is

given where a patent is refused, and we regard these provisions as applicable in trade-mark cases under § 9 of the Act of February 20, 1905."

After quoting as above from *Atkins v. Moore*, this court said:

"We are of opinion that the principle there announced controls this case."

In *American Steel Foundries v. Whitehead, Commissioner of Patents*, 256 U. S., 40, decided on the same date as *Baldwin v. Howard*, appellant's petition for writ of certiorari, to review a decision of the Court of Appeals of the District of Columbia affirming the refusal of the Commissioner of Patents to register appellant's trade-mark "SIMPLEX" had been granted, and the case fully argued upon the merits without any objection being raised by this court or by counsel to the jurisdiction of this court. This court, however, dismissed the cause and in doing so said (p. 41):

"... This case is ruled by Nos. 139 and 113 (*Baldwin v. Howard*), just decided, *ante*, 35. As the writ of certiorari in this case, for the reasons stated in the opinion in No. 139, was improvidently granted, it follows that the cause must be dismissed for want of jurisdiction, and it is so ordered."

Pursuant to the above decisions, appellant, acting upon the ruling of this court that it had the right to a review of the decision of the Court of Appeals of the District of Columbia affirming the decision of the Commissioner of Patents refusing to register its trade-mark, through the filing of a bill in equity under Section 4915 R. S., filed its bill in this cause only to have it dismissed by the District Court on the ground that an applicant for the registration of a trade-mark could not proceed by bill in equity under Sec. 4915 R. S.

Appellant is therefore in the unfortunate position of

having had this court refuse to consider the merits of its case on the ground that appellant had the right to file a bill in equity under Sec. 4915 R. S., and of having the District Court refuse to consider the merits of its case on the ground that appellant did not have the right to file a bill in equity under Sec. 4915 R. S.

This Court Has Adjudicated, and Not Merely Stated Through Obiter Dictum, That a Trade-Mark Applicant Has a Statutory Right to File a Bill in Equity Under Sec. 4915, R. S.

Counsel for appellee, Simplex Electric Heating Company, urged before the District Court that the repeated holding of this court in *Gaines v. Knecht*; *Atkins v. Moore*; *Baldwin v. Howard*; and *American Steel Foundries v. Whitehead*, *supra*, that:

“ . . . by § 4915 a remedy by bill in equity is given where a patent is refused, and we regard these provisions as applicable in trade-mark cases under § 9 of the Act of February 20, 1905,”

was mere *obiter dictum*, and hence not entitled to be treated as authoritative. Such contention, we submit, was entirely erroneous, as the consideration of the facts before this court in each of the said decisions shows that it was necessary for this court to hold that a trade-mark applicant did have the right to proceed under Sec. 4915 R. S., in order to arrive at such decisions.

In each of the said cases, this court held that the decision of the Court of Appeals of the District of Columbia sought to be reviewed was not a final decision, and hence not reviewable by this court under either Sec. 250 of the Judicial Code, providing for appeals from final judgments or decrees of the Court of Appeals of the District of Columbia, or Sec. 251, providing for the

granting of a writ of certiorari in cases in which the judgment or decree of the Court of Appeals of the District of Columbia is not made final.

The only reason why a decision of the Court of Appeals of the District of Columbia on an appeal from the Commissioner of Patents is not final, is, that the controversy may be further contested through bill in equity under Sec. 4915 R. S. Except for such right, such a decision would be final, inasmuch as it would conclude the controversy between the parties and would not be subject to review.

The decision of the District of Columbia Court of Appeals affirming the decision of the Commissioner of Patents in refusing to register appellant's trade-mark "SIMPLEX" is not interlocutory, but is final in the sense that it concludes the entire matter in controversy, namely, appellant's right to register its trade-mark, and would be final in the sense that it is not reviewable, unless appellant does have the right to do that which it did do, namely, file a bill in equity under Sec. 4915 R. S.

This court in *Macfarlane v. Brown*, 187 U. S., 239, quoted with approval from its previous decision in *Bostwick v. Brinkerhoff*, 106 U. S., 3, the following definition of a final judgment or decree (p. 246):

"The rule is well settled and of long standing that a judgment or decree to be final, within the meaning of that term as used in the acts of Congress giving this court jurisdiction on appeals and writs of error, must terminate the litigation between the parties on the merits of the case, so that if there should be an affirmance here, the court below would have nothing to do but to execute the judgment or decree it had already rendered."

Counsel for appellee, Simplex Electric Heating Company, in support of his contention that the holding by this court in the four decisions referred to, that Sec.

9 of the Trade-Mark Act conferred the right to file a bill in equity under Sec. 4915 R. S. was *obiter dictum*, urged that a decision of the Court of Appeals on an appeal from the Commissioner of Patents was not a final decision, irrespective of whether a bill in equity might be filed to further contest the right to registration of a trade-mark, and in support of such argument, cited and quoted from the decision of the Court of Appeals of the District of Columbia in *Rousseau v. Browne*, 21 App. D. C. 73, 80. In the said decision, which was also cited by this court in *Frasch v. Moore*, and *Baldwin v. Howard*, an appeal to this court was refused in a patent interference proceeding which had been appealed from a decision of the Commissioner of Patents, on the ground that its decision was not a final judgment under the statute then in force providing for appeals from decisions of the District of Columbia Court of Appeals to this court, namely, the Act of February 9, 1893, the provisions of which act relating to appeals from the Court of Appeals of the District of Columbia to this court were superseded by Sec. 250 of the Judicial Code.

Although reference was not made in the opinion in *Rousseau v. Browne* to the right of an applicant for a patent to file a bill in equity under Sec. 4915 R. S., after his application had been refused by the Court of Appeals of the District of Columbia, yet the court must have had in mind that such further proceeding was open to an applicant for a patent, as otherwise its decision in affirming the decision of the Commissioner refusing the grant of a patent would have been a conclusion of the entire controversy, and hence a final decree.

The court in its said opinion did refer to the fact that Sec. 4914 R. S. provides that no decision of the District of Columbia Court of Appeals rendered on an

appeal from the Patent Office would preclude a contest as to the validity of a patent, obviously, as a basis for its holding, that a decision on an appeal from the Patent Office was not final when it resulted in the granting of a patent, as the validity of such patent when granted would be open to attack.

A decision of the District of Columbia Court of Appeals affirming the Patent Office in refusing to grant a patent, "terminates the litigation between the parties on the merits of the case," and is therefore a final decision, except that the applicant may further contest his right to a patent by filing a bill in equity under Sec. 4915 R. S.

Counsel for appellee, Simplex Electric Heating Company, further contended before the District Court that the decision of the Court of Appeals was not final because Sec. 4914 R. S. relating to an appeal to the District of Columbia Court of Appeals from the Commissioner of Patents provides that:

"After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case."

The fact that the decision of the court is certified to the Commissioner of Patents has no bearing whatever upon the finality of such decision, any more than does the certifying of a decision of any Appellate Court, through the issuance of its mandate to an inferior court, deprive the decision of the Appellate Court of its finality. Nor does the fact that Sec. 4914 R. S. provides that the decision of the court "shall govern the further proceedings in the case" in the Patent Office, in any wise militate against the finality of the decision, any more than does the fact that in every case decided by

an Appellate Court the decision controls the action of the lower court, deprive such decision of finality.

The only further procedure in the Patent Office after a decision of the Court of Appeals affirming the refusal of the Commissioner to grant a patent, is the filing of the decision of the court in the application, just as the only proceeding in a lower court when a superior court has affirmed a decision dismissing a bill of complaint, is the filing of the mandate.

A decision of the Court of Appeals of the District of Columbia affirming a decision of the Patent Office rejecting an application for a patent is final, except for the procedure permitted by Sec. 4915 R. S., as it leaves nothing further to be done by the Patent Office.

It is therefore submitted that the decision of the Court of Appeals affirming the Commissioner of Patents in his refusal to register appellant's trade-mark was not a final decision only because this court held that Sec. 9 of the Trade-Mark Act conferred upon appellant the right to proceed by a bill in equity under Sec. 4915 R. S. Consequently the holding of this court that a trade-mark applicant may proceed by a bill in equity, was not merely *obiter dictum*, but was an adjudication.

Construction of Sec. 9 Trade-Mark Act.

The repeated holding of this court that Sec. 9 of the Trade-Mark Act confers upon an applicant for the registration of a trade-mark the right to proceed by a bill in equity, is in accord with *Gandy v. Marble*, 122 U. S. 432, in which it was held that the proceeding by bill in equity under Sec. 4915 R. S. "is, in fact and necessarily, a part of the application for the patent." In that case this court held that an applicant for a patent was pre-

cluded from filing such a bill in equity because it had not been filed within two years after the decision of the Court of Appeals of the District of Columbia affirming the decision of the Patent Office, the statutory period then being two years within which an application for a patent must be prosecuted.

This court said (p. 440):

“ . . . The jurisdiction of the application being transferred, *pro tanto*, to the court, by virtue of the bill in equity, it cannot adjudge that the applicant is entitled, according to law, to receive a patent, unless he shows to the satisfaction of the court that the delay was unavoidable, under an allegation to that effect in the bill. The presumption of abandonment, under Sec. 4894, unless it is shown that the delay in prosecuting the application for two years and more after the last prior action, of which notice was given to the applicant, was unavoidable, exists as fully in regard to that branch of the application involved in the remedy by bill in equity as in regard to any other part of the application, whether so much of it as is strictly within the Patent Office, or so much of it as consists of an appeal to the Supreme Court of the District of Columbia under Sec. 4911. The decision of the court on a bill in equity becomes, equally with the judgment of the Supreme Court of the District of Columbia on a direct appeal under Sec. 4911, the decision of the Patent Office, and is to govern the action of the Commissioner. It is, therefore, clearly a branch of the application for the patent, and to be governed by the rule as to laches and delay declared by Sec. 4894 to be attendant upon the application.”

The above decision that the filing of a bill in equity is merely a transfer of the jurisdiction over the application to the court, and that the proceedings in the court are merely a branch of the application and are governed by the procedure imposed upon “the application while in the jurisdiction of the Patent Office,”

is clearly a precedent for the later decisions of this court that the filing of a bill in equity under Sec. 4915 R. S. by the applicant for registration of a trade-mark, is part of the proceedings in such application.

Unless the last clause of Sec. 9 of the Trade-Mark Act, "the same rules of practice and procedure shall govern in every stage of such proceedings, as far as may be applicable," refers to the filing of a bill in equity under Sec. 4915 R. S., it would apparently be meaningless, as after the appeal from the Commissioner of Patents to the Court of Appeals of the District of Columbia, there are no other proceedings possible, and in every sense the decision of that court would be final.

History of Trade-Mark Act of February 20, 1905.

It is recognized that reports to Congress accompanying the introduction of proposed laws may be referred to by courts in reaching the true meaning of the legislature in cases of doubtful interpretation (*Caminetti v. United States*, 242 U. S. 470). As the District Court apparently thought that, notwithstanding the clear decisions of this court, the meaning of Sec. 9 of the Trade-Mark Act was not clear, it may be of interest to briefly refer to the circumstances which preceded the passing of the Trade-Mark Act.

Congress, by the Act of June 4, 1898, provided for the appointment by the President of a commission of three to revise the patent and trade-mark laws. The commission submitted an exhaustive and elaborate report to Congress on November 27, 1900, which was printed as Senate Document No. 20, 56th Congress, and comprised drafts of bills for two proposed Trade-Mark Acts, one supported by two of the Commissioners, and the other by the third Commissioner, which were introduced in successive Congresses.

The bill recommended by the majority of the Commissioners contained, as Section 20 thereof, a provision similar to Section 4915 R. S. of the Patent Laws, whereas the bill recommended by the minority of the Commission, which was introduced by Mr. Currier on April 19, 1904, as H. R. 15,223, contained no such provision, but did contain, as Section 12 thereof, the identical section subsequently enacted as Section 9 of the Trade-Mark Act, with the exception that it did not contain the last clause of Section 9 of the Trade-Mark Act, namely:

“and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.”

At the beginning of the third session of the 58th Congress, H. R. 16,560 was introduced by Mr. Bonyng, and was referred to the committee on patents, which committee subsequently reported the bill and recommended its passage (Report No. 3147). This bill, with minor amendments, was passed by Congress and approved by the President on February 20, 1905, and is the present Trade-Mark Act.

The fact that in the bill as recommended by the committee on patents, Section 12 of the bill previously introduced as H. R. Bill 15,223 was incorporated as Section 9, but with the addition thereto of the clause above quoted, raises the presumption that such clause was added in order that the bill might confer upon trade-mark applicants the right to proceed by a bill in equity under Sec. 4915 R. S., otherwise, apparently, there would have been no occasion for adding said clause to the said section as it appeared in the previous bill.

That it was the intention of Congress in passing the Trade-Mark Act to confer upon applicants for registration of trade-marks the same privileges and rights as to

procedure in prosecuting their applications as had been previously conferred upon applicants for patents, is indicated by Sec. 22, which corresponds to Sec. 4918 R. S. of the patent law, and by Sec. 18, which provides as follows:

“Sec. 18. That writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under this act in the same manner as provided for patent cases by the act creating the circuit court of appeals.”

That such was the intention of Congress is further indicated by the statement by Mr. Bonyng, a member of the Patent Committee, who introduced the bill subsequently enacted into the present Trade-Mark Law, as follows:

“This bill provides for such an appeal to the Circuit Court of Appeals of the District of Columbia, the same as in patent cases, and the procedure for the registration of Trade-marks is modeled after the procedure for the obtaining of a patent.” *Congressional Record*, 217, 39, part 1, 58th Congress, 3rd Session, January 14, 1905, p. 885.

Different Character of Rights Secured by Patent From Those Secured by Trade-Mark Registration.

Counsel for appellee, Simplex Electric Heating Company, urged before the District Court, in support of his contention that Sec. 9 of the Trade-Mark Act should not be construed, as this court has repeatedly construed it, to confer upon trade-mark applicants the same right that Sec. 4915 R. S. gives to patent applicants, that the rights which are secured by a patent are different from those which are derived through the registration of a trade-mark. It is true that while an inventor has no exclusive right to his invention except through the granting of a patent covering the same, the proprietor of a

trade-mark acquires a common-law right thereto by its adoption and use, regardless of its registration in the Patent Office.

A trade-mark proprietor does, however, secure valuable rights through the registration of its trade-mark. The registration constitutes *prima facie* evidence of ownership of the trade-mark (Sec. 16). Registration of a trade-mark vests exclusive jurisdiction in the Federal Courts over suits for infringement thereof, so that the proprietor of a registered trade-mark has the advantage of proceeding in the Federal Courts regardless of diverse citizenship of the parties (Judicial Code, Sec. 24, par. 7). The registration of a trade-mark in this country is a condition precedent to registration in many foreign countries. The rights secured through the registration of a trade-mark are valuable, and the fact that they differ in character from the rights secured through a patent, should not in any wise militate against the interpretation which this court has given to Sec. 9 of the Trade-Mark Act, through which interpretation a trade-mark applicant is given the same right to further prosecute his right to registration, by a bill in equity, under Sec. 4915 R. S., as has an applicant for a patent.

Although the characteristic differences in the rights secured by a patent and by the registration of a trade-mark are well known, nevertheless, Congress deemed it wise, through the Trade-Mark Act, to give to trade-mark applicants the same right of appeal from the Commissioner of Patents to the Court of Appeals of the District of Columbia as is given to patent applicants, and also to confer upon trade-mark applicants other privileges of procedure similar to those granted to patent applicants, such, for instance, as the right of review by this court, through the grant of writs of certiorari in cases arising

under the Trade-Mark Act, in the same manner as provided for patent cases (Sec. 18, Trade-Mark Act).

Vast property rights have been secured by proprietors of trade-marks through the adoption and use of trade-marks in connection with their commodities, which rights are not only of value to the trade-mark proprietors as a protection against loss of trade through unscrupulous imitators of their trade-mark, but to the public through the protection afforded to it against imposition by those who seek to palm off their commodities as the commodities of a competitor through the imitation of the competitor's trade-marks.

The right of review through a bill in equity of the refusal of the Court of Appeals of the District of Columbia to register a trade-mark, secured to trade-mark proprietors through the interpretation which this court has given to Sec. 9 of the Trade-Mark Act, is one of great importance, both to trade-mark proprietors and to the public generally.

Stare Decisis.

Since the decisions of this court in *Atkins v. Moore* (decided in November, 1909), and in subsequent cases holding that a trade-mark applicant had the right to proceed by bill in equity to secure registration of its trade-mark after such registration had been refused by the Court of Appeals of the District of Columbia, such right has been exercised by various trade-mark proprietors with the approval of the District Courts.

Old Lexington Club Distillery Co. v. Kentucky Distilleries (District Court, D. N. J.), 234 Fed., 464, was a suit by bill in equity under Sec. 4915 by a trade-mark proprietor. The defendant filed a demurrer based upon

various grounds, and in his unreported decision in overruling the same, Judge Cross said:

"This matter is before the Court upon a demurrer to the bill of complaint, which is founded upon Section 4915 of the Revised Statutes, and Section 9 of the Trade-Mark Act, of February 20, 1905. . . .

"Thereupon this proceeding was instituted under Section 4915 of the Revised Statutes, which provides in part as follows:

" 'Whenever a patent is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia, upon an appeal from the decision of the Commissioner, the applicant may have his remedy by bill in equity.'

"The word 'patent' as used in the above statute, has been held by the Supreme Court to apply to trade-marks. *Frasch v. Moore*, 211 U. S. 1. *Atkins v. Moore*, 212 U. S., 285."

Hercules Powder Co. v. Newton, Commissioner of Patents, 254 Fed., 906, was another suit brought by a trade-mark proprietor under the provisions of Sec. 4915 R. S., in which the then Commissioner of Patents consented to the jurisdiction of the District Court of the State of New York, just as the present Commissioner consented to the jurisdiction of the District Court, Northern District of Illinois, Eastern Division, in the case at bar.

Other instances in which trade-mark proprietors have filed bills in equity under Sec. 4915 R. S. are:

Chero-Cola Co. v. Coca-Cola Co., now pending in the District Court, Northern District of Georgia, Northern Division;

McIlhenny Co. v. New Iberia Extract & Tabasco Pepper Co., now pending in the District Court for the Eastern District of Louisiana, New Orleans Division; and

McIlhenny Co. v. Trappey et al., now pending in the same District Court.

Conclusion.

In conclusion, it is submitted on behalf of appellant that:

(1) This court has held in four cases that Sec. 9 of the Trade-Mark Act of February 20, 1905 gives a trade-mark proprietor the right to further prosecute his application for registration by a bill in equity under Sec. 4915 R. S., after registration has been refused by the Court of Appeals of the District of Columbia.

(2) A decision of the District of Columbia Court of Appeals affirming the decision of the Commissioner of Patents refusing an application for registration of a trade-mark concludes the controversy, and would be final were it not for the right of the applicant to further prosecute his application by bill in equity under Sec. 4915 R. S., and hence the decisions of this court that such a decision of the Court of Appeals of the District of Columbia is not final, necessarily adjudicated that a trade-mark applicant has the right to proceed under Sec. 4915 R. S.

(3) The interpretation which this court has given to Sec. 9 of the Trade-Mark Act is in accord with the spirit and intent of said act, to confer upon trade-mark proprietors the same rights as to procedure in prosecuting applications for trade-mark registration, as are conferred by the Patent Statutes upon applicants for patents.

(4) Relying upon the authority of the decisions of this court, trade-mark proprietors whose applications for registration have been refused by the Court of Appeals of the District of Columbia, have filed bills in equity under Sec. 4915 R. S., and their right to do so has been recognized by various District Courts.

(5) The decision of the District Court dismissing appellant's bill of complaint, filed under Sec. 4915 R. S., for want of jurisdiction, should be reversed.

Respectfully,

GEORGE L. WILKINSON,

HENRY M. HUXLEY,

Counsel for Appellant.

CHICAGO, ILLINOIS, February 10, 1923.

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Supreme Court of the United States.

OCTOBER TERM, 1922.

No. 291.

AMERICAN STEEL FOUNDRIES,

APPELLANT,

v.

THOMAS E. ROBERTSON, COMMISSIONER OF PAT-
ENTS, AND SIMPLEX ELECTRIC HEATING

COMPANY,

APPELLEES.

BRIEF FOR APPELLEE SIMPLEX ELECTRIC
HEATING COMPANY.

STATEMENT OF THE CASE.

Question Presented.

The sole question presented by this appeal is the jurisdiction of the United States District Court to maintain a bill in equity to secure the registration of a trade-mark under section 4915 R.S., which provides for obtaining patents by such a bill. The United States District Court for the Northern District of Illinois, Eastern Division, dismissed such a bill, purporting to be brought under this section, for want of jurisdiction.

The Facts.

The fact as stated in the appellant's brief are not disputed. It might in addition be noted—

(9) On October 5, 1921, the motion to dismiss for lack of jurisdiction was argued orally before the Court.

Point of Law Relied Upon.

The appellant in its brief states the point of law relied upon to be that section 9 of the Trade-Mark Act of February 20, 1905, confers upon an applicant for registration of a trade-mark the right to file a bill in equity under section 4915 R.S.

The appellee relies upon the point of law that neither section 9 of the Trade-Mark Act of February 20, 1905, nor any other statutory provision confers such a right.

The Motion.

The defendant's motion, which was granted by the District Court without opinion, but after full agreement by both parties, was as follows:

“And now comes Simplex Electric Heating Company for this purpose allowed to intervene and moves to dismiss the Bill for lack of jurisdiction in this Court over the subject matter or alleged cause of action and on the ground that this cause is not a suit arising under the trade-mark laws of the United States, under section 9 of the act of February 20, 1905, under Section 4915 of the Revised Statutes of the United States or under section 24, sub-section 7, of the Judicial Code, as alleged in paragraph 2 of the Bill of Complaint.”

BRIEF.**The Jurisdiction of the District Court.**

The jurisdiction of the District Court must be derived from some statute or act of Congress. This is fundamental.

“Circuit Courts [now District Courts] do not derive their judicial power, immediately, from the Constitution, as appears with sufficient explicitness from the Constitution itself Consequently the jurisdiction of the Circuit Court in every case must depend upon some act of Congress, as it is clear that Congress, inasmuch as it possesses the power to ordain and establish all courts inferior to the Supreme Court, may also define their jurisdiction. Courts created by statute can have no jurisdiction in controversies between party and party but such as the statute confers” (citing cases).

Grover & Baker v. Florence Sewing Machine Co., 18 Wall. 553.

“The case turns upon the jurisdiction of the Supreme Court of the District to entertain the suit. Registration of trade-marks, opposition to registration, cancellation of registration, and interference proceedings are all governed by statute. 33 Stat., sec. 724 *et seq.* The solution of any question which arises with respect to these matters must be in harmony with the terms of the statute. *Lincoln vs. Virginia Portland Cement Co.*, 49 App. D.C. 33; *More vs. United States*, 249 U.S. 487; *United States vs. Temple*, 105 U.S. 97.

If there is no statutory authority for bringing the suit, then the action of the lower court must be reversed and the amended bill dismissed."

Robertson, Commissioner of Patents, and R. S. Howard Co., Intervener, v. The United States of America, ex rel. The Baldwin Co., 52 App. D.C.

For this reason Equity Rule 25 requires the bill to contain—

"Second, a short and plain statement of the grounds upon which the court's jurisdiction depends."

In the attempt to meet this requirement the bill herein alleged—

"2. This is a suit arising under the trade-mark laws of the United States, (Section 9 of the Act of February 20, 1905, as interpreted in *Atkins vs. Moore*, 212 U.S. 285, 29 Sup. Ct. 390), also under Section 4915 of the Revised Statutes of the United States, also under Section 24, sub-section 7, of the Judicial Code."

Taking these three items thus stated by the bill as the grounds for the jurisdiction of the District Court, we consider them in their reverse order.

First. The section of the Judicial Code relied upon reads:

"Section 24. The District Courts shall have original jurisdiction as follows:

• • • • •
"Seventh. Of all suits at law or in equity

arising under the patent, the copyright and the trade-mark laws."

But this simply defines the District Court as the Court to have jurisdiction if a right of action is given by statute under any of the three classes of laws named.

Second. Section 4915 R.S., referred to by the bill, reads:

"Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

But this section on its face relates solely to a bill in equity to secure a *patent*, and has nothing whatever to do with the entirely different subject of *trade-mark* registration.

Third. Section 9 of the Trade-Mark Act of February 20, 1905, referred to by the bill, reads:

“That if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the court of appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.”

This statute again on its face relates solely and entirely to a right of appeal from the Commissioner of Patents to the Court of Appeals of the District of Columbia in applications for trade-mark registration, oppositions thereto, etc. This section of the act—

- (a) gives the right of appeal in these cases.
- (b) makes the conditions requisite for such appeal the same, so far as applicable, as—

“in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention.”

- (c) provides that—

“the same rules of practice and procedure shall

govern in every stage of such proceedings, as far as the same may be applicable."

Nothing could be more clear than this plain and direct language giving this right of appeal and making the conditions precedent and the practice and procedure the same as in the similar appeals provided in connection with patents for inventions.

This precise point was before the Court of Appeals of the District of Columbia in the recent case of *Robertson, Commissioner, and Howard Co. v. The United States of America, ex rel. The Baldwin Co.*, 52 App. D.C. , wherein that Court said:

"It will be observed that section 9 of the trademark statute, *supra*, so much relied upon by the Baldwin Company, deals with appeals from the Commissioner of Patents to this court, and declares that the rules of practice and procedure in patent cases shall govern in every state of 'such proceedings' as far as they may be applicable. What proceedings? Clearly, the proceedings followed in taking the appeals just mentioned. There is nothing in it which purports to deal with what shall happen after an appeal has been determined. Section 4914 says that no decision by this court shall preclude any person interested from the right to contest the validity of a patent 'in any court wherein the same may be called in question'. This relates to something that may take place after the decision of this court, and has no relation to proceedings in an appeal from the Commissioner to this court. And what is said with respect to this section may also be said with

respect to section 4915, which deals with patent cases after they have been disposed of by this court or by the Commissioner in case no appeal is taken to this court. There is nothing in it which relates to an appeal from the Commissioner to this court, and therefore, it cannot affect 'such proceedings'. Besides, Congress has provided by section 22 of the trade-mark statute (33 Stat. 729) for proceedings in equity after a case has been finally disposed of by this court. It is there declared that 'whenever there are *interfering registered trade-marks*, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant'. (Italics ours). But no provision is made for a suit in equity in a case such as the one before us. Does not this call for the application of the maxim *Expressio unius est exclusio alterius?*'

Nothing, we respectfully submit, could be more clear than the fact that this section 9 of the Trade-Mark Act does not give or pretend to give any new and original right of action in connection with trade-mark registration.

The plaintiff's case for jurisdiction must then depend upon its allegation "as interpreted in Atkins vs. Moore, 212 U. S. 285, 29 Sup. Ct. 390."

No Statute Gives or Purports to Give or can be Construed as Giving Such a Right of Action as would Sustain the Present Bill.

We are not unmindful of the language of this Court in *Atkins v. Moore*. But a careful review of the stat-

utes and authorities will show unquestionably, we submit, that there is no statutory authority for the present asserted right of action, and that neither this Court nor any other Court has considered and decided to the contrary.

The deference due to any language used by this Court in an opinion requires a careful examination of the statutes and authorities, and to such an examination we now pass.

The **Patent Laws** from earliest times have always contained three separate and distinct provisions:

First Provision. A right of review in the nature of an appeal from the Commissioner's refusal to grant the patent. The act of 1836 provided a special board which was to certify its decision to the Commissioner, whereupon—

“he shall be governed thereby in the further proceedings to be had on such application.”

This right of appeal by the Acts of 1839 and 1852 was transferred to the chief judge or one of the assistant judges of the then Circuit Court of the District of Columbia; by the Act of July 8, 1870, it was transferred to the Supreme Court of the District of Columbia; and by the Act of February 9, 1893, to the present Court of Appeals of the District of Columbia.

Second Provision. An original and independent right of action by bill in equity to secure the grant of a patent. This was conferred by section

16 of the Act of 1836 and continued thereafter and remains in force in the provisions of present section 4915 R.S., *supra*.

Third Provision. An original and independent right of action by bill in equity in the case of interfering patents. This also was conferred by section 16 of the Act of 1836 and continued thereafter and remains in force in the provisions of present section 4918 R.S., *supra*.

The **Trade-Mark Law** never contained any of these three provisions or anything similar thereto prior to the Act of February 20, 1905, now in force. Referring to this present Act as to these three provisions, we find:

First Provision. A right of review in the nature of an appeal from the Commissioner. This is contained in section 9 of the act, *supra*.

Second Provision. An original and independent right of action by bill in equity to secure the issuance of a registration certificate. *This is entirely lacking.*

Third Provision. An original and independent right of action by bill in equity in the case of interfering *registered* trade-marks. This is contained in very similar language to the corresponding section 4918 R.S., relating to patents in section 22 of the Trade-Mark Act, as follows:

“That whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him,

by suit in equity against the said registrant; and the court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation."

While the Trade-Mark Act, therefore, in section 22, provides for a bill in equity in the case of *interfering registered trade-marks*, there is no provision for such a bill in equity in the case of *proceedings in opposition* to the registration of a trade-mark, in the case of *proceedings for the cancellation* of a trade-mark registration, or in the case of *interfering applications* for trade-mark registrations.

There is substantial evidence to show that the failure to include in the Trade-Mark Act a provision corresponding to section 4915 R.S. and giving an independent right of action in the District Court to secure the registration of the trade-mark was intentional on the part of Congress. Prior to the passage of the present Trade-Mark Act, Congress, by the Act of June 4, 1898, provided for the appointment by the President of a Commission to revise the patent and Trade-Mark Laws. This Commission on November 27, 1900, submitted an exhaustive and elaborate report to Congress, accompanying the same with a proposed Trade-Mark Law in the form of a bill. This bill contained in its section 20 a provision similar to section 4915 R.S. of the Patent Laws, and with respect

to this section, which never was enacted by Congress, the Commissioners in their report said:

“Section 20 provides for obtaining registration by suit in equity. This is substantially a copy of a similar provision for compelling the grant of a patent for an invention (R.S. Section 4915).”

The appellant in its brief refers to the bill recommended by the minority member of the Commission, which did not contain any such provision, and alleged that this minority bill did contain—

“the identical section subsequently enacted as Section 9 of the Trade-Mark Act, with the exception that it did not contain the last clause.”

This is not quite correct. The minority bill was of an entirely different character from that recommended by the Commission, and section 12 of the minority bill was quite different from even the first part of the present section 9 of the Trade-Mark Act. Section 12 as proposed by the minority member of the Commission read as follows:

“That if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the court of appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention.”

The bill which actually was passed by Congress and became the present Trade-Mark Act of February 20, 1905, was that introduced by Mr. Bonyng, H.R. 16,560, Fifty-eighth Congress (Report No. 3147), and referred to in appellant's brief. In this report of the House Committee on Patents it was said:

"Your committee has carefully examined the report of the Commissioners above named [referred to supra] and the provisions of the bill proposed by them, in connection with the provisions of the various bills on the same subject referred to your Committee, and after such examination it is the unanimous opinion of your Committee that the bill submitted herewith would be constitutional legislation."

This bill contained present section 9 and omitted section 20 submitted by the Commission and which contained provisions similar to section 4915 R.S.

Not only does it thus appear that any provision in the present Trade-Mark Act similar to section 4915 R.S. of the Patent Act was deliberately omitted by Congress, but it also appears from the same report No. 3147 that the concluding provision of section 9 of the Trade-Mark Act—

"and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable"—

related solely to the rules and procedure for such appeals, because the report states:

"A further appeal is provided by Section 9

from the decision of the Commissioner of Patents to the Court of Appeals of the District of Columbia, and the same rules and procedure for such appeals are adopted as those which control appeals from the decision of the Commissioner on an application for a patent or parties to an interference as to an invention."

A Bill in Equity under Section 4915 R.S. of the Patent Act is an Original and Independent Proceeding.

That an action under section 4915 R.S. of the Patent Act is an original and independent action is well settled by this Court in *Butterworth v. Hoe*, 112 U.S. 61, and in *Morgan v. Daniels*, 153 U.S. 120. This proposition has always been adhered to by the Courts.

In *Greenwood v. Dover* the Circuit Court of Appeals for the First Circuit, 194 Fed. 91, said:

"Dover claims that the proceeding in the Circuit Court was in no way in the nature of an appeal, but an independent suit in equity, as to which proposition there is no doubt.

"The proposition is too plain to require discussion that there is no peculiarity as between this and any other independent suit in equity.

"Morgan v. Daniels, 153 U.S. 120, . . . is full of expressions to this effect."

In the recent case of *Central Railway Signal Co. v. Jackson*, 254 Fed. 103, the Court decided this very point, saying:

"It is in consequence in effect urged by counsel

on both sides of this question that the validity of service is dependent upon the other question of whether such a bill, as has been filed in this case, is an original proceeding or appellate. It is clear that the proceeding is technically not appellate. The statutes relating to the issue of patents provide for successive appeals, the purpose of which is to secure a review of any rulings made, and, if proper, a reversal of those rulings. Such proceedings are strictly and technically appellate. It is likewise clear that section 4915 strictly and technically gives original and independent jurisdiction to the court to adjudge, it is true, the same claim of right which was made in the other proceedings, and to reach a judgment which is different from, and in that sense a reversal of, the ruling made by the Patent Office, but the ruling thus first made remains and is not technically reversed.

"This is the view expressed by the court in *Butterworth v. Hoe*, 112 U. S. at page 61, 5 Sup. Ct. 25, 28 L. Ed. 656. The view thus expressed is entirely consistent with the comments made upon it in *Gandy v. Marble*, 122 U. S. at page 439, 7 Sup. Ct. 1290, 30 L. Ed. 1223.

"The comment that 'the proceeding is in fact and necessarily a part of the application for the patent' is *ex vi termini* obviously true, because the sole purpose of such a bill is to secure the grant of a patent.

"The distinction before pointed out, however, remains that the proceeding, though necessarily part of the application for a patent, is an indepen-

dent proceeding, and not appellate, in the sense of being an appeal from the ruling first made. In other words, although its purpose is to secure the issue of a patent, the issue of which has been refused, it does not seek that issue through a reversal of the ruling first made, but through an independent finding that the applicant is entitled upon the merits of his application to a patent. In a very practical sense the result is a reversal, but such is not its legal purpose or effect.

“The correct view, as presented in *Butterworth v. Hoe*, is that Congress has provided two modes of procedure through and by which a patent may issue. One is the usual application to the Commissioner of Patents. The other is by bill in equity. It is true that resort cannot be had to the latter until recourse has been first had to the former, but the two proceedings none the less are distinct, separate, and independent, and in all other respects than that indicated are in the alternative. This results in the conclusion that no aid can be accorded the plaintiffs through the expedient of viewing the present proceedings as an appellate one, and we are driven to the provisions of R. S. Sec. 4915, for such aid as is within the power of this court to afford.”

The appellant's brief herein misapprehends the point decided in *Gandy v. Marble*, 122 U.S. 432. This case in no way alters the ruling in *Butterworth v. Hoe*, 112 U.S. 50, which distinguished the proceeding by bill in equity under section 4915 from an appeal under section 4911, and held, with respect to the former:

“This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office.”

All that was decided in *Gandy v. Marble* was that, if the application in the Patent Office had already become abandoned under the provisions of section 4894, then it was too late to bring a bill in equity under section 4915.

In *Barrett Co. v. Ewing, Commissioner*, 228 O.G. 761 (not elsewhere reported), in the Southern District of New York, Judge Hough, a case subsequently affirmed by the Circuit Court of Appeals of the Second Circuit in 242 Fed. 506, the action was under section 4915 R.S. to secure certain patents, the applications for which had been refused upon appeal to the Court of Appeals of the District of Columbia. Previous to dismissing the bill on the merits Judge Hough said:

“This action confessedly seeks to make a kind of superior Patent Office out of this court and its appellate tribunals. The right to bring such an action is anomalous, and though as long as the statute stands it must be recognized,”

The Clear Distinction between a Patent Which Grants the Property Right in an Invention and a Trade-mark Registration Which Merely Registers a Right Secured at Common Law Warrants the Omission from the Trade-Mark Act of Anything Similar to Section 4915 R.S.

The reason which doubtless actuated Congress in conferring this additional, peculiar, original, and in-

dependent right of action to secure a patent for an invention and for withholding it for the purpose of securing a trade-mark registration is obvious and well founded. In the case of a patent the very right to the monopoly of the invention is secured and granted by the patent. Without the patent there would be no monopoly. The refusal of the patent is therefore a serious matter. On the contrary, a trade-mark registration confers no property right to the trade-mark. The property right in a trade-mark arises under the common law. This right exists and continues to exist whether the registration be granted or refused.

Furthermore, the Trade-Mark Act itself makes the registration only *prima facie* evidence, for in section 16 it is provided—

“That the registration of a trade-mark under the provisions of this act shall be *prima facie* evidence of ownership.”

This proposition is argued very thoroughly and, we submit, conclusively by the Court of Appeals of the District of Columbia in its recent decision in *Robertson and Howard Co. v. United States of America, ex rel. The Baldwin Co., supra*, wherein it is said:

“There is a good reason why Congress should have provided for equitable relief in patent cases as it has done in Section 4915 without making a like provision for trade-mark cases. If the section did not exist the applicant for a patent would be concluded by the decision of this court holding that his invention was not patentable. He might manufacture and put it on the market and successfully defeat anyone who might charge him

with being an infringer, but he could not obtain a monopoly himself. *Brown vs. Duchesne*, 19 How. 183; *Dable Grain Shovel Co. vs. Flint*, 137 U. S. 41. Against his will his invention could be made and vended by anybody with impunity. Moreover, a patent conveys a property right to the inventor. *Imperial Cotto Sales Co. vs. N. K. Fairbanks Co.*, 50 App. D.C. 250, 270 Fed. 686; *Shaw vs. Cooper*, 7 Pet. 292; *Cammeyer vs. Newton*, 94 U.S. 225. To be denied a patent is to be denied this right, which may be very valuable.

“In the case of a trade-mark the situation is entirely different. The registration of a mark conveys no property right (*Sarrazin vs. W. R. Irby Cigar & Tobacco Co.*, 93 Fed. 624; *Hanover Star Milling Co. vs. Allen & Wheeler Co.*, 208 Fed. 513; *Andrew Jergens Co. vs. Woodbury, Inc.*, 273 Fed. 952, 965) and its cancellation takes none away. Ownership of the mark depends upon its adoption and use, not on its registration. *Columbia Mill Co. vs. Alcorn*, 150 U.S. 460; *Phillips vs. Hudnut et al.*, 263 Fed. 643. The only effect of the registration is to raise a rebuttable presumption in favor of the registrant’s ownership. Section 16 of the trade-mark act says that the registration of a trade-mark shall be *prima facie* evidence of ownership. 33 Stat. 728. If in a contest between a registrant and one who is using the same mark upon the same class of goods the latter can establish that he is the owner of the mark, the registration of it will avail the other party nothing. The right to a patent originates in the statute. The right to a trade-mark exists inde-

pendently of a statute and comes into existence by reason of its adoption and use. (See authorities *ante*.) Under section 4915 the inventor may secure a monopoly of his invention, which he could not otherwise obtain, but the owner of a trade-mark could secure nothing which he did not have before except a presumption which might be overturned by proof. The one would gain much, the other very little. There is a reason, then, for section 4915 with respect to patents, but little reason for it with respect to trade-marks. To our mind these things indicate why section 4915 does not apply, either directly or by reference, to trade-mark cases."

The Trade-Mark Act appears to be based upon the very proper theory that the desirable thing is to insure the prevention, so far as possible, of improper registration. Such improper registration may cause a great deal of expense, inconvenience, and damage to competitors in business. But the refusal of a registration can do little harm. Every *bona fide* trade-mark is well protected under the common law and without registration. In confirmation of this general proposition it will be noted that by section 12 registry endures indefinitely, being renewed upon request by the payment of a small fee that by section 6 any person who believes he would be damaged may file an opposition to the registration within thirty days after it is first published and be entitled to a trial; that by section 7 an interference is declared between two pending applications to register similar marks for similar goods which results in a trial; and that by section 13,

even after registration has taken place, any person who deems himself injured may apply for the cancellation of the registration and be entitled to a trial.

Any or all of these various proceedings may be taken, under section 9, on appeal to the Court of Appeals of the District of Columbia.

If the decision of that high Court advises the refusal or cancellation of registry, the public interests are subserved and the applicant is left to his common-law rights.

In only one case does the Trade-Mark Act specifically provide for any original proceeding in the Courts having to do with this matter. This is section 22, which takes care of the case *where two or more interfering registrations have actually been granted*. In such cases the act provides for an original bill in equity, which may result in the cancellation of either or all of the registrations.

We respectfully submit, therefore, that there are good and sufficient reasons why the appeal provided in trade-mark cases to the Court of Appeals of the District of Columbia is ample, and that there is no good reason why Congress should have provided for trade-marks a section like 4915 R.S. of the Patent Act.

The Misinterpretation of *Atkins v. Moore*.

The only remaining ground asserted by the plaintiff for the jurisdiction of the Court below is the language of this Court in the case of *Atkins v. Moore*, 212 U.S. 285. Whatever may be argued from the phraseology of the opinion in this case, the meaning of the decision is clear. This Court did not have before it in that case, nor has it ever had before it until now, the

question as to whether section 4915 R.S. of the Patent Act has become a part of the Trade-Mark Act.

The only real question which has been before this Court and actually decided by it so far as the questions here involved are concerned is simply this:

Is the decision of the Court of Appeals of the District of Columbia under section 4914 R.S. providing for the appeal in patent cases, or under section 9 of the Trade-Mark Act of February 20, 1905, in trade-mark cases, a "final judgment" or a "final decree?" For unless this decision be a *final* judgment or decree, there can neither be an appeal, a writ of error, nor a writ of certiorari from or to the Supreme Court. This appears from the Judicial Code:

"Sec. 250. Any final judgment or decree of the Court of Appeals of the District of Columbia may be reexamined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in the following cases:

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 "Except as provided in the next succeeding section, the judgments and decrees of said court of appeals shall be final in all cases arising under the patent laws, the copyright laws, the revenue laws, the criminal laws, and in admiralty cases; and, except as provided in the next succeeding section, the judgments and decrees of said court of appeals shall be final in all cases not reviewable as hereinbefore provided.

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 "Sec. 251. In any case in which the judgment

or decree of said court of appeals is made final by the section last preceding, it shall be competent for the Supreme Court of the United States to require, by certiorari or otherwise, any such case to be certified to it for its review and determination, with the same power and authority in the case as if it had been carried by writ of error or appeal to said Supreme Court."

This is the precise holding of this Court in the very latest cases: *Baldwin Co. v. Howard Co.* and *American Steel Foundries v. Whitehead, Commissioner, supra*. Therein the Court said:

"If the decision of the court of appeals of the District of Columbia is not final, then the motion to dismiss the appeal should be sustained and we have no authority to grant a writ of certiorari"—

and held the decision of the Court of Appeals of the District of Columbia—

"In no sense a final judgment, reviewable here upon writ of certiorari or appeal."

This, we respectfully submit, is the only thing which has been decided by this Court and the only thing that was before it for decision, namely, whether or not the decision of the Court of Appeals of the District of Columbia on these appeals was a *final* judgment or decree. The history of the consideration and decision of this point is pertinent and conclusive.

The matter first came up, so far as we find it reported, in *Rousseau v. Brown*, 21 App. D.C. 73, 80, where, after the Court of Appeals of the District of

Columbia had made and certified its decision on appeal to the Commissioner of Patents in a patent interference, Chief Justice Alvey, in refusing to allow a writ of error or appeal to the Supreme Court, said:

“There is no final judgment of this court rendered in such cases, nor is there any such judgment required or authorized to be rendered, not even for costs of the appeal. This court is simply required in such cases, after hearing and deciding the points as presented, instead of entering judgment here, to return to the Commissioner of Patents a certificate of the proceedings and decision of this court, to be entered of record in the Patent Office, to govern the further proceedings in the case. But it is declared by the statute that no opinion of this court in any such case shall preclude any person interested from the right to contest the validity of any patent that may be granted by the Commissioner of Patents. D. C. Rev. Stat. Sec. 780, U. S. Rev. Stat. Sec. 4914.

“There is no provision of any statute, within our knowledge, that authorizes a writ of error or an appeal to the Supreme Court of the United States in such case as the present. It would seem clear that the case is not within the purview of Sec. 8 of the act of Congress of February 9, 1893, providing for the establishment of this court. That section only applies to cases where final judgments by this court have been entered, and not to decisions to be made and certified to the Patent Office, under the special directions of the statute.”

Later, when *Frasch v. Moore, Commissioner*, came

before the same Court, 27 App. D.C. 25, Chief Justice Shepard allowed an appeal and a writ of error, saying:

“We are inclined to the view that this case is not appealable to the Supreme Court of the United States, but as the question has never been directly decided, so far as we are advised, we will grant the petition in order that the question of the right to appeal in such a case may be directly presented for the determination of the court of last resort.”

When this case came before this Court, 211 U.S. 1, this Court quoted and adopted the opinion of Chief Justice Alvey in *Rousseau v. Brown*, *supra*, dismissed the appeal and writ of error, and denied certiorari. This Court at the outset of this opinion said:

“The decision of the Court of Appeals sought to be reviewed in the present case is not final”—

and quoted the various statutes giving the right of appeal to the Court of Appeals of the District of Columbia. It is true that in discussing the question this Court went on to call attention to the fact that, if the patent were granted as a result of the appeal, it still would not—

“preclude any person interested from the right to contest the validity of any patent that may be granted by the Commissioner of Patents”—

and referred to section 4914 R.S. The Court also called attention to section 4915 R.S. as giving a further remedy to the applicant if the patent were refused.

All of this reference by this Court to section 4915 R.S. was, strictly speaking, unnecessary. It was for the purpose of showing that Congress had been lenient—extremely lenient—in providing additional remedies, so that there was no good reason for Congress not doing as it had done in making the decision of the Court of Appeals of the District of Columbia an advisory proceeding rather than a final judgment. The argument of the Court was not to show that the decision was not final; that had been decided by the Court definitely at the very outset of its opinion.

Moreover it is evident, we respectfully submit, that the providing, or the failure to provide, by Congress of an additional, original, and independent right of action could not affect the character of the decision of the Court of Appeals of the District of Columbia as to its finality.

This question next arose in *Gaines v. Knecht*, 212 U.S. 561. This case involved a trade-mark opposition and was taken by writ of error to the Court of Appeals of the District of Columbia. This Court, by a memorandum, dismissed the writ of error for want of jurisdiction, referring to *Frasch v. Moore*, 211 U.S. 1. This was obviously in accordance with its previous holdings, because the question of the finality of the decision of the Court of Appeals of the District of Columbia was not altered by the fact that a trade-mark proceeding, rather than a patent proceeding, was involved.

The next case involving the point was that of *Atkins v. Moore*, under discussion. This Court here dismissed for want of jurisdiction an appeal from, and a writ of error to, the Court of Appeals of the District

of Columbia affirming the Commissioner of Patents in refusing to register a trade-mark. Here again the Court, citing *Frasch v. Moore*, *supra*, and *Gaines v. Knecht*, *supra*, held that in both patent and trade-mark proceedings these decisions of the Court of Appeals of the District of Columbia were "not final judgments or decrees." The Court then discussed at length *Gaines v. Knecht*, elaborating its previous memorandum opinion, and concluded by saying:

"In the light of the various details of the act of February 20, 1905, and of the specific provisions of Sec. 9, we were of opinion that proceedings under the act were governed by the same rules of practice and procedure as in the instance of patents, and the writ of error was accordingly dismissed. The same result must follow in the present case."

This decided the case and the only point that was before the Court. The Court, however, went on to mention, as it had in *Frasch v. Moore*, that as a matter of fact in patent cases there was still an additional remedy provided by Congress, referring to section 4915 R.S., and then said:

"We regard these provisions as applicable in trade mark cases under Sec. 9 of the act of Feb. 20, 1905."

This was clearly unnecessary, and neither had nor could have anything to do with the decision of the Court which had already been made.

The next case to come before the Court was *Beckwith v. Commissioner*, 252 U.S. 538, where a writ of

certiorari was allowed to bring up the decision of the Court of Appeals of the District of Columbia affirming the Commissioner of Patents in refusing to register a certain trade-mark. No one raised the question of jurisdiction, and the Court decided the case, reversing the Court of Appeals.

The next cases were those of *Baldwin Co. v. Howard Co.*, *supra*, and *American Steel Foundries v. Whitehead, Commissioner*, *supra*, which have resulted in the case at bar. In these cases this Court again repeated its holding as we have already pointed out. It made clear that the only question either in *patent* or in *trade-mark* cases was whether or not the decision of the Court of Appeals of the District of Columbia on appeal from the Commissioner of Patents was a final judgment or decree. The Court said:

“If the decision of the court of appeals of the District of Columbia is not final, then the motion to dismiss the appeal should be sustained, and we have no authority to grant a writ of certiorari. Judicial Code, Sec. 250, 251”—

and found:

“It is in no sense a final judgment, reviewable here upon writ of certiorari or appeal.”

The Court referred to its inadvertent assumption of jurisdiction in *Beckwith v. Commissioner*, *supra*, as inconclusive, and discussed its previous decisions on the point.

The opinion of this Court was retained in the case of *Baldwin Co. v. Howard Co.*, *supra*, and it is to be noted that this case involved a proceeding to cancel the

two trade-mark registrations which had been issued and were outstanding. The Court of Appeals of the District of Columbia, in 48 App. D.C. 437, had affirmed the Commissioner of Patents in directing cancellation of these registrations. This Court, in the case referred to, dismissed an appeal from and a writ of certiorari to the Court of Appeals of the District of Columbia on the ground that the decision of the lower Court was not a final judgment or decree. Now it is evident that the loser, The Baldwin Company, had no further remedy, because there can be no pretense that section 4915 R.S. gives the District Court any power to cancel a patent already issued. This section covers the question only of the *obtaining* of a patent, and the proceedings under it can only be brought by or on behalf of an *applicant* for a patent. The right to the registration was thus destroyed by the decision of the Court of Appeals of the District of Columbia, although that decision was not a final decree or judgment, as decided by this Court, and The Baldwin Company, the loser, could have no further day in Court, even if section 4915 R.S. of the Patent Act could be read into the Trade-Mark Act.

The appellant in the case at bar urges that it is in "an unfortunate position." The only thing "unfortunate" is that the appellant has had its day in court under the statutory provision allowed one seeking to obtain the *prima facie* and rebuttable presumption conferred by a certificate of registration and the decision has gone against it.

In addition we take the liberty of quoting again from the very recent decision of the Court of Appeals of the District of Columbia in *Robertson and Howard*

Co. v. United States of America, ex rel. The Baldwin Co., supra, in which this precise question here at bar was decided and in which the foregoing decisions of this Court were carefully reviewed and analyzed. In that decision the Court of Appeals said:

“In construing the opinion of a court reference must be had to the facts involved, and to the question to which the court’s mind was directed when formulating the decision. *Cohens vs. Virginia*, 6 Wheat. 264; *Plumley vs. Massachusetts*, 155 U.S. 461, 471; *Harriman vs. Northern Securities Co.*, 197 U.S. 244, 291. In the *Atkins* case it appeared that *Atkins & Co.* made application for registration of a trade-mark in the Patent Office. The application was denied, and on appeal to this court the decision was affirmed. An appeal and writ of error were allowed by the Supreme Court of the United States. The court dismissed both on the ground that our order affirming the decision of the Commissioner was not final. In support of its conclusion the court called attention to its decision in *Frasch vs. Moore*, 211 U.S. 1, in which it was held that our decisions on appeals from the Patent Office are interlocutory and not final; also to the decision in *Gaines vs. Knecht*, 212 U.S. 561, where a ruling to the same effect was made. After quoting with approval from our decision in *Gaines vs. Knecht*, 27 App. D.C. 530, 532, the court said that, in the light of the various details of the act of February 20, 1905, (Trade-Mark Act) and of the specific provisions of Section 9, to which we have already called attention, it was of the opinion that proceedings under the

act were governed by the same rules of practice and procedure as in the instance of patents, and the writ of error was accordingly dismissed. Then it added that under section 4914, R.S., *supra*, no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes any person from the right to contest the validity of such patent in any court wherein the same may be called in question, and that by section 4915 a remedy by bill in equity is given where a patent is refused, and that it regarded these provisions as applicable in trade-mark cases under section 9 of the act of February 20, 1905.

“That the act of February 20, 1905, makes it clear that the decisions of this court in trade-mark cases are not final is beyond question. (See section 16) But the thing which makes trouble is the observation that the court regards the provisions of section 4915 applicable in trade-mark cases under section 9 of the act of February 20, 1905. We do not think that the court was considering anything but the question as to whether or not the decision of this court was final. That was the point before it and the one on which the thought of the court was centered. The provisions of the trade-mark act, especially section 16, furnished ample authority for the conclusion which it has reached. The court had no occasion to determine whether section 4915 gave a defeated applicant for registration the right to commence a proceeding in equity, and we do not think it intended to so decide. In this we are supported by a statement in the last opinion of the court

upon the subject. *Baldwin Co. vs. Howard Co., supra.* Mr. Justice Day, who spoke for the court in that case, after referring to the decisions in the *Frash*, *Atkins*, and *Gaines* cases, wherein the various statutory sections about which we have been writing were referred to, said: 'No provision is made which permits this statutory proceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia, the decision of which court is directed to be certified to the Commissioner of Patents.' The statutory proceeding referred to is the one relating to the registration of trade-marks, the decisions of the Commissioner touching the same, and the review of his decisions by this court. This proceeding, according to the learned justice, can not be carried beyond the decision of the Court of Appeals. In other words, the questions of registration, cancellation, opposition, and interference in trade-mark cases are ended by our decision. The only thing decided in such a proceeding is as to whether or not the mark shall be registered, or, having been registered, whether or not it shall be cancelled. The effect of the registration as we have seen, is simply to provide a rule of evidence which under section 16, *supra*, casts upon him who would attack the right of the registrant to the mark the burden of establishing his claim in an infringement, unfair competition, or other proper proceeding. We think the court had this in mind when it said that there was no authority for carrying the statutory proceeding beyond the decision of the Court of Appeals."

The history of the decisions of the Supreme Court upon this point is therefore, we respectfully submit, clear and consistent. The somewhat gratuitous reference of the Court to the fact that in patent cases the applicant still had an additional remedy available in section 4915 R.S. had nothing to do with the decision of the point in question, and the further statement that this remedy was also made available in trade-mark cases by section 9 of the Trade-Mark Act of February 20, 1905, was not only immaterial to the decision of the point before the Court, but it evidently did not have the consideration of the Court. Certainly if, as is obvious, the Supreme Court cannot be bound by an inadvertent assumption of jurisdiction as in *Beckwith v. Commissioner, supra*, it cannot be bound by any such inadvertent statement as that upon which the plaintiff relies in *Atkins v. Moore, supra*. To base jurisdiction upon any such statement is, for the reasons which we have set forth, we respectfully submit, to overlook the real points decided by the Court and to pay attention only to a remark of the Court not necessary to nor involved in its decision.

The Nature of the Decision of the Court of Appeals of the District of Columbia.

The statutory provisions already quoted and the decisions referred to show that this high Court in patent and trade-mark cases possesses peculiar and limited power. It renders no final judgment or decree; it can issue no process of execution nor command the issuance of any in these cases; it can render no judgment for costs; all it can do is to certify its decision to the Commissioner.

In *Wells v. Reynolds*, 3 App. D.C. 43, a motion was made for judgment for costs. In denying the motion the Court, through Chief Justice Alvey, said:

“Upon consideration of this motion, the Court has concluded that under the law it has no power or jurisdiction to award costs, or to execute any judgment therefor, that might be entered to cases of appeals from the Commissioner of Patents. The motion is therefore denied.”

The ancillary or advisory character of the proceedings in the Court of Appeals of the District of Columbia is evident from the well-certain limitations applying to these proceedings. For instance, in interference cases the Court cannot even consider and decide the question of prior public use where the evidence is before it in the record, nor can it consider the case of the patentability of the invention.

Lacroix v. Tyberg, 33 App. D.C. 586.

Burson v. Vogel, 29 App. D.C. 388.

Mell v. Midgley, 31 App. D.C. 534.

Sobey v. Holsclaw, 28 App. D.C. 65.

But there is no difference in the provision of the statute applying to appeals in interference cases from that applying to appeals in any other cases involving patent or trade-mark proceedings. In each case the Court is required only to—

“return to the Commissioner a certificate of its proceedings and decision.”

In neither case has it any power to enter a judgment or decree; in neither case is its finding or conclusion

enforceable by any process of execution issued by it or by any other Court; in neither case can it render any judgment for costs.

It is not unusual for Congress to provide for such an advisory proceeding by the Courts. The Court of Claims has long exercised such jurisdiction under the 12th section of the Act of March 3, 1887, now appearing in substance in section 148 of the Judicial Code. The original provision of the Act of March 3, 1887, was—

“When the facts and conclusions of the laws shall have been found, the Court shall report its findings to the department by which it was transmitted.”

In the case of *In re Sanborn*, 148 U.S. 222, this Court held that such a proceeding did not result in a final judgment, and held it to be “ancillary and advisory only.” The main reason given by this Court was that—

“The finding or conclusion reached by that Court is not enforceable by any process of execution issuing from the Court”

The Courts have not infrequently commented upon the somewhat peculiar situation resulting from these decisions. One of the most interesting cases in which this was considered may be briefly referred to.

Judge Putnam, speaking for the Circuit Court of Appeals of the First Circuit, in *Greenwood v. Dover*, 194 Fed. 91, said:

“It is to be regretted that Congress has not provided that decisions like that in the Court of

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Appeals in Greenwood vs. Dover should be conclusive, in the same way in which any decisions of the superior courts of federal or state jurisdiction are ordinarily held to be effectual. While the proceedings in the Patent Office out of which this decision arose were not strictly in accordance with the practice either at law or in equity in the jurisdictions where the common law prevails, yet they have all the elements of the fundamental principles of the 'law of the land' and might well have been pronounced by Congress to end the litigation accordingly, and thus to avoid the opportunity of further holding up of patents, and of leaving the rights of both the public and the patentee indecisive for another series of years. The entire proceeding contains the great elements required by the 'law of the land', namely, opportunity for both parties to be heard, and finally a decision by a court of high authority, endowed with all the machinery of superior courts of judicature. As it is, however, we are compelled to accept in this single particular the view claimed by Dover, that the judgment of the Court of Appeals stands akin to a departmental decision, although no court could avoid the impression that in a certain sense and to a certain extent it is of greater weight."

It follows that if the decisions of the Court of Appeals of the District of Columbia in any patent matter were final judgments or decrees, the argument of Judge Aldrich in his concurring opinion would be conclusive and the proceedings under section 4915

would have to be in the nature of a proceeding to set aside a judgment or decree. But no Court has ever held that these decisions in any case, involving either a trade-mark matter or a patent matter, were final judgments or decrees, and in proceedings on bill in equity under section 4915 in patent cases these decisions have only been regarded with respect, or, as Judge Putnam said, as "akin to a departmental decision."

In many respects the decision of the Court of Appeals of the District of Columbia and the certificate which it is authorized by the statute to send to the Commissioner of Patents are similar to the proceedings considered many years ago by this Court in probate matters in the District of Columbia.

In the case of *Van Ness v. Van Ness*, 6 How. 62, it appeared that letters of administration were sought by the widow of the deceased in the Orphans' Court in the District of Columbia. The right to such letters of administration was given to the widow by an act of Maryland passed in 1798 and adopted by Congress for the District of Columbia in 2 Statutes at Large, 103. The same act of the State of Maryland made it the duty of the Orphans' Court, if required by either party, to direct an issue to be sent for trial to any Court of law most convenient for trying it, and, in the language of the opinion of Chief Justice Taney, 6 How. 63:

"the court to which it is sent is authorized to direct the jury, and to grant a new trial if it thinks proper, as if the issue were in a suit therein instituted; and upon a certificate from such court, or a judge thereof, of the verdict or finding

of the jury, under the seal of the court, the Orphans' court is directed to give judgment upon such finding."

In this case the issue as to whether or not Mary A. Van Ness was the widow of the deceased was sent to the Circuit Court of the District of Columbia for trial, and that Court certified to the Orphans' Court, under the provisions of the statute, that she was not the widow. Thus the matter at issue in the Orphans' Court, so far as substance was concerned, was finally determined in the Circuit Court, and the claim of Mrs. Van Ness to be the widow, and therefore to be entitled to letters of administration, was completely destroyed.

A writ of error to the Circuit Court was brought from the finding or certificate of that Court to this Court, and motion was made to dismiss the case for want of jurisdiction. In its opinion this Court said:

"The appellate power of this court in relation to the circuit court for the District of Columbia is regulated by the act of congress of February 27, 1801. And it authorizes the writ of error to the circuit court in those cases only in which there has been final judgment, order, or decree in that court. Whatever errors, therefore, may have been committed, and however apparent they may be in the record, yet we have not the power to correct them unless the circuit court has passed a final judgment, order, or decree in the case before it."

A similar argument was made in that case to that

which has been made before this Court in those cases wherein it has been sought to take an appeal or writ of certiorari from the decision of the Court of Appeals of the District of Columbia sending a certificate to the Commissioner of Patents under section 4914 R.S. According to the opinion in the Van Ness case—

“The argument on the part of the plaintiff is, that inasmuch as the verdict was found in obedience to the positive instructions of the court, and as the certificate of the finding of the jury was conclusive upon the orphans’ court, the order of the circuit court to certify the verdict to the orphans’ court ought to be regarded as a final judgment or order within the meaning of the act of congress.”

But this Court held:

“And the order of the circuit court, directing a fact to be certified to another court to enable it to proceed to judgment, can hardly be regarded as a judgment, order, or decree, in the legal sense of these terms as used in the act of congress. Certainly it is not a final judgment or order. For it does not put an end to the suit in the orphans’ court, as that court alone can dismiss the petition of the plaintiff which is there pending, and no other court has the power to pass a judgment upon it.

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“Upon the whole, therefore, this court is of the opinion that there has been no final judgment, order, or decree in the circuit court, and the writ

of error must be dismissed for want of jurisdiction."

The same question arose again in *Brown v. Wiley*, 4 Wall. 165. In this case issues were sent by the Orphans' Court of the District of Columbia to the Supreme Court of the District of Columbia, which, by 12 Statutes at Large, 763, had then been substituted for the Circuit Court. The issues were tried by the Supreme Court of the District of Columbia. Exceptions were taken under the statute then in force to the general term of the Supreme Court of the District of Columbia, and according to the statement of this Court—

"Thereupon an order was entered by the court, before which the issues had been tried, directing that the finding of the jury on the issues sent from the Orphans' Court be certified by the clerk to said Orphans' Court.

"The writ of error in this case was sued out, that the foregoing *order* might be brought up to this court."

It will be noted that the writ of error was directed to the order of the Supreme Court of the District of Columbia, or, in other words, to the certificate of that Court. An attempt was made to distinguish this case from the *Van Ness* case, but this Court said:

"We are unable to perceive that the difference is material. The order certifying the finding to the Orphans' Court, in the case of *Van Ness*, was identical in effect with the two orders overruling the motion for new trial, and certifying the find-

ing in the case before us. In each case the exceptions taken at the trial before the jury were overruled, and nothing was left for action in the court before which the issues were tried; but the cause went to the Orphans' Court for final judgment.

"In that case it was held that the order was not one which could, under the act, be re-examined on writ of error, and we see no reason for a different ruling in this."

Notwithstanding the fact that—

"The only matters in controversy in the Orphans' Court were those embraced in the issues sent for trial into the court below. The verdict of the jury destroyed the claim of Marshall Brown to the succession"—

this Court held that the order or certificate was not a final judgment, order, or decree of the Supreme Court of the District of Columbia which could be re-examined upon writ of error or appeal.

These two cases of *Van Ness v. Van Ness* and *Brown v. Wiley* were again re-examined by this Court in *Ormsby v. Webb*, 134 U.S. 47. Although in both cases no power remained in the Orphans' Court except to dismiss the petition, this Court held that—

"the order of the Circuit Court, directing a fact to be certified to another court to enable it to proceed to judgment, can hardly be regarded as a judgment, order or decree, in the legal sense of these terms as used in the act of Congress. Certainly it is not a final judgment or order. For it does not put an end to the suit in the Orphans'

Court, as that court alone can dismiss the petition of the plaintiff which is there pending; and no other court has the power to pass a judgment upon it."

When the case of *Ormsby v. Webb* arose, the law had been changed, so that the Orphans' Court had become merged in the Supreme Court of the District of Columbia and the final judgment rendered by the Supreme Court of the District of Columbia holding the Orphans' Court made upon issues framed and tried by the same Court sitting as a Circuit Court had become subject to review in this Court.

Stare Decisis.

The appellant in its brief seeks to invoke the rule of *stare decisis*, but the appellant is evidently not familiar with the facts.

Old Lexington Club Distillery Co. v. Kentucky Distilleries, 234 Fed. 464. We have been unable to find that the question here involved was squarely put in issue in that case. The appellant's brief does not state the grounds of the demurrer, and the excerpt from the unreported opinion of Judge Cross appears to be a mere recitation of the claim for jurisdiction.

Hercules Powder Co. v. Newton, Commissioner of Patents, 254 Fed. 906. The defendant here did not raise the question, but, on the contrary, as shown by the opinion, consented to the jurisdiction of the Court to determine the action as a Court of original jurisdiction.

Loughran v. Quaker City Co., 281 Fed. 186. This was a proceeding in a trade-mark case purporting to be

taken under section 4915 R.S. The opinion specifically states:

“No question of the right of the plaintiff to maintain a bill for this purpose is raised.”

Chero-Cola Co. v. Coca-Cola Co., pending in the District Court for the Northern District of Georgia, Northern Division, and referred to on page 21 of appellant's brief. The defendant in this case moved to dismiss the bill for want of jurisdiction over the subject-matter. The motion was argued on February 8th last, and up to the time of writing this brief had not been decided.

McIlhenny Co. v. New Iberia Co. and McIlhenny Co. v. Trappey et al. These cases, referred to on page 21 of appellant's brief, are pending in the District Court for the Eastern District of Louisiana, New Orleans Division. In both cases the defendant moved to dismiss the bill for want of jurisdiction over the subject-matter. The motion was argued February 1st last before his Honor Judge Foster. Judge Foster was informed of the pendency of the present case before this Court, and is holding the motion under advisement awaiting the decision of this Court.

Robertson, Commissioner, and R. S. Howard Co. v. The United States of America, ex rel. The Baldwin Co., supra. This case, already referred to in this brief, was decided February 5th last by the Court of Appeals of the District of Columbia, and up to the time of preparing this brief had not appeared in published form. It decides the very question at issue in a carefully considered opinion by the learned Chief Justice of that Court, and holds that section 4915 R.S. does

not apply in trade-mark cases, and consequently that the lower Court had no jurisdiction.

American Steel Foundries v. Robertson and Simplex Electric Heating Co. This is the case at bar, in which the question of jurisdiction is raised and in which the bill was dismissed for want of jurisdiction by his Honor Judge Carpenter.

These are all the cases which we have been able to find and which the appellant has been able to suggest. It therefore appears that, where the question has been squarely considered and decided, it has been against jurisdiction.

Conclusion.

In conclusion it is submitted in behalf of the appellee that—

(1) The jurisdiction of the District Court is strictly statutory.

(2) There is no statutory provision carrying section 4915 of the Patent Act over into the Trade-Mark Act.

(3) There is no good reason for giving an applicant seeking to obtain the merely *prima facie* standing and rebuttable presumption furnished by a trade-mark registration the benefit of the very unusual proceeding provided by section 4915 R.S. for an applicant for a patent which grants a substantial property right.

(4) The decisions of the Court of Appeals of the District of Columbia on appeals from the Commissioner of Patents in patent and trade-mark cases are not final judgments or decrees, and this independently of any right to proceedings under section 4915 R.S.

(5) The history of the trade-mark legislation shows that there was no intent to provide an original and independent action in trade-mark matters arising in the Patent Office except in the case of interfering trade-mark registrations actually issued and outstanding.

(6) Where the question here involved has been considered and decided by the lower Courts, it has been against jurisdiction.

(7) The decision of the District Court to dismiss appellant's bill of complaint for want of jurisdiction is therefore correct, and should be affirmed.

Respectfully submitted,
NATHAN HEARD,
Of Counsel for Appellee
SIMPLEX ELECTRIC HEATING COMPANY.

BOSTON, MASSACHUSETTS, March 21, 1923.